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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/736,468 | 12/14/2003 | Walter E. Pipo | PipoE_CIP_1_03 | 3489 |
| 34442 | 7590 | 09/21/2005 | EXAMINER | |
| PATRICIA M. COSTANZO PATENT COPYRIGHT TRADEMARK LAW 2960 BOWEN ROAD ELMA, NY 14059 | | | CARIASO, ALAN B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2875 | |

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,468

Applicant(s)

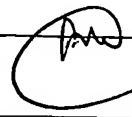
PIPO ET AL.

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 8-12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031214.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “locking means for securely holding said light source means in place” (claim 17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
3. Each page of at least pages 2-20 have words or phrases that are incomplete. Some examples are: page 2, line 2, "Th"; page 3, line 2, "oth r transpar nt"; page 4, line 2, "d scribed"; page 5, line 1, "b"; page 5, last line, "embed d"; page 5, line 1, "th optical fibers ar expos d at a visually xpos d".

Appropriate correction is required.

Claim Objections

4. Claims 2 and 5 are objected to because of the following informalities:
5. Claim 2, line 2, the term "on" appears to be an incorrect term in the context of "at least *on* receptacle".
6. Claim 5, line 2, the term "m ans" appears to be missing an intermediate letter.

Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7, 13-16 and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 1, 2, 5-7, 13-16, 18 of copending Application No. 10/661,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1, 19 and 20, the claimed self-illuminating fabricated solid object assembly of '420 application (indicated in parenthesis) comprises at least one visually exposed surface (at least one visually exposed surface '420 claim 1), at least one aperture (ditto), said aperture opening on an accessible surface (at least one aperture open to an outer surface), at least one optical fiber (ditto) positioned within said solid object (embedded within said fabricated solid object), a first end of said optical fiber visually terminating at said visually exposed surface of said solid object (said first end of said fiber arranged to terminate at said at least one visually exposed surface of said fabricated solid object), a second end of said optical fiber operatively related to said aperture to receive light (said second end of said receptacle operatively coupled with said aperture, said second end of said receptacle adapted to reversibly receive said light source providing for operative contact of said light source with said second end of said fiber), whereby light emitted from an exchangeable light source means is transmitted to said visually exposed surface of said solid object by said optical fiber (at least one reversibly powered light source with said second end of said receptacle ...

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whereby light is emitted from said visually exposed surface of said fabricated object); claim 2, further comprising at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light (at least one receptacle embedded within said solid object, said receptacle having at least a first and a second end, said first end of said receptacle adapted to encompass said second end of said at least one optical fiber, said second end of said receptacle operatively coupled with said aperture; '420 claim 1); claim 3, further comprising said at least one receptacle receiving an exchangeable light source providing for transmission of light from said exchangeable light source to said first end of said optical fiber visually terminating at said at least one visually exposed surface of said solid object (at least one reversibly powered light source with said second end of said receptacle ... whereby light is emitted from said visually exposed surface of said fabricated object, '420 claim 1); claim 4 (ditto claim 2); claim 5, said any known solidification means includes any known molding means (said any known solidification means includes molding techniques, '420 claim 5); claim 6 (claim 6); claim 7 (claim 7); claims 13-16 & 18 (claims 13-16 & 18 of '420).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7, 13, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by GILBERT (US 3,943,815).

11. GILBERT discloses a self-illuminating fabricated solid object assembly (10, fig.1) comprising: at least one visually exposed surface (30), at least one aperture (the opening of hollowed out portion 54, fig.3), said aperture (opening of 54, fig.3) opening on an accessible surface (12), at least one optical fiber (60) positioned within said solid object (10), a first end (33',35',37',33",35",37") of said optical fiber (60) visually terminating at said visually exposed surface (30) of said solid object (10), a second end (adjacent 56, fig.3) of said optical fiber (60) operatively related to said aperture (opening of 54, fig.3) to receive light (from adjacent light source 56), whereby light emitted from an exchangeable light source means (56) is transmitted to said visually exposed surface (30) of said solid object by said optical fiber (60); claims 2, 19 and 20, further comprising at least one receptacle (hollowed-out portion 54, col.2, line 35) operatively relating to or functionally associated with said at least one aperture (opening of 54, fig.3), said receptacle (54) receiving said second end (fig.3) of said optical fiber (60) providing for said second end of said optical fiber to receive light (from light source 56), of a fiber optic cable (60) received by said receptacle (54); claim 3, further comprising said at least one receptacle (54) receiving an exchangeable light source (56) providing for transmission of light from said exchangeable light source (56) to said first end (33',35',37',33",35", 37") of said optical fiber (60) visually terminating at said at least one

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visually exposed surface (30) of said solid object (10); claim 6, where said at least one optical fiber (60) further comprises a plurality of optical fibers (col.2, lines 64-66); claim 7, wherein each first end (33',35',37',33",35", 37") of each of said plurality of optical fibers (60) is positioned to define at least one predetermined pattern (col.1, line 66 to col.2, line 9) on said visually exposed surface (30) of said object (10); claim 13, wherein said self-illuminating object assembly further comprises a notched base (symbol-shaped cuts on body 12-fig.1 or fretted apertures 33'-47' in neck 14); claim 17, wherein said at least one receptacle (54) comprises locking means (illustrated as U-brackets (fig.2) that hold onto lamp 56) for securely holding said light source means (56) in place; .

12. As for claims 4 and 5, please note that the method of forming the device is not germane to the issue of patentability of the device itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these (i.e. method) limitations have not been given patentable weight.

13. Claim 1-3, 6, 13, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by CLARKE (US 2,501,160).

14. CLARKE discloses a self-illuminating fabricated solid object assembly (10, 11) comprising: at least one visually exposed surface (12, 13), at least one aperture (col.4, lines 1-4 or space occupied by light source 25-fig.1), said aperture (25) opening on an accessible surface (12), at least one optical fiber (44-49) positioned within said solid object (10,11), a first end (14-18) of said optical fiber (44-49) visually terminating at said visually exposed surface (12,13) of said solid object (10,11), a second end (adjacent light bulbs, fig.2) of said optical fiber (44-49) operatively related to said aperture (fig.2) to receive light, whereby light emitted from an exchangeable light source means (25) is transmitted to said visually exposed surface (12,13) of said solid object (10,11) by said optical fiber (44-49); claims 2, 19 and 20, further comprising at least one receptacle (30,34,36,38, col.3, lines 63-71, fig.4) operatively relating to or functionally associated with said at least one aperture (col.4, lines 1-4 or space occupied by light source 25-fig.1), said receptacle (30,34,36,38) receiving said second end (fig.1) of said optical fiber (44-49) providing for said second end of said optical fiber to receive light (from light sources 33,35,37,39); claim 3, further comprising said at least one receptacle (30,34,36,38) receiving an exchangeable light source (33,35,37,39) providing for transmission of light from said exchangeable light source (33,35,37,39) to said first end of said optical fiber (44-49) visually terminating at said at least one visually exposed surface (12,13) of said solid object (10); claim 6, where said at least one optical fiber (44-49) further comprises a plurality of optical fibers (fig.2); claim 13, wherein said self-illuminating object assembly further comprises a notched base (23).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over CLARKE (US 2,501,160) in view of HOWLETT (US 3,609,343) and LEGARE (US 5,160,202).

17. Claim 14 recites said illuminating object further comprises statuary, a paving stone, and building block not disclosed by CLARKE. HOWLETT teaches a fiber optic illuminated statuary (22) for the purpose of displaying with illumination other forms of display. LEGARE teaches paving stones or curbstones with incorporated lighting devices for the purpose illuminating static displays. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lighting system for display models of CLARKE to include the statuary object and paving stone or building block as taught by HOWLETT and LEGARE, respectively, in order to make versatile the illumination system when formed with other forms of displays.

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over GILBERT (US 3,943,815) in view of SHIH (US 6,234,657).

19. GILBERT discloses the claimed invention except a light emitting diode. SHIH teaches the use of LED (50,50") for the purpose of producing colored light. It would

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have been obvious to one having ordinary skill in the art at the time the invention was made to modify the illuminated solid object assembly of GILBERT to include the type of LED light source as taught by SHIH in order to produce colored lighting and facilitate circuit manipulation with use of LEDs in further adding the aesthetics of the lighted display.

Allowable Subject Matter

20. Claims 8-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

21. The following is a statement of reasons for the indication of allowable subject matter: Claims 8-12 have allowable subject matter not suggested by the prior art of record, the light source additionally comprises at least one fiber optic cable in combination with at least one receptacle operatively relating to said at least one aperture opening on an accessible surface, the receptacle receiving the light source providing for transmission of light from said exchange light source to said first end of said optical fiber visually terminating at the visually exposed surface of the solid object, the optical fiber positioned within the solid object.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. KOPELMAN (US 4,924,612) shows a fiber optic cable (18-fig.1B

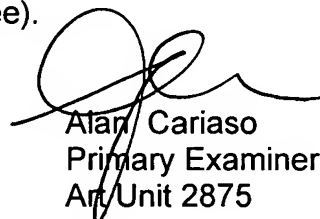
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or 80,81,85 in fig.5) intermediately connected between fiber optic channels (26) of a fiber optic plastic (23-fig.1B or 77a, 78a or 79a in fig.5) and light source (15-fig.1B or 87-fig.5). TAMURA et al (JP 6049804A) show a concrete block (1) with embedded and exposed optic fibers (2,3,4) associated with a light-source-receiving receptacle (8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso
Primary Examiner
Art Unit 2875

September 19, 2005
AC